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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,292	01/11/2005	Thomas Daniel	29827/40753	1444
4743	7590	06/16/2006	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606				BERNSHTEYN, MICHAEL
ART UNIT		PAPER NUMBER		
		1713		

DATE MAILED: 06/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/521,292	DANIEL ET AL.
	Examiner	Art Unit
	Michael Bernshteyn	1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1-10 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-10 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

1. This Office Action follows a response filed on March 24, 2006. Applicants have amended claim 1.
2. Claims 1-10 are pending.

***Claim Rejections - 35 USC § 102***

3. The test of this section of Title 35, U.S.C. not included in this action can be found in a prior Office Action.

***Claim Rejections - 35 USC § 103***

4. The test of this section of Title 35, U.S.C. not included in this action can be found in a prior Office Action.
5. Claims 1-5 and 8-10 are rejected under 35 U.S.C. 102(b) as anticipated by Tsubakimoto et al. (U.S. Patent 4,286,082) for the rationale recited in paragraph 4 of Office Action dated on October 27, 2005.
6. Claims 6 and 7 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Tsubakimoto et al., for the rationale recited in paragraph 5 of Office Action dated on October 27, 2005.

***Response to Arguments***

7. According to the amendments made by the Applicants, the objection of the specification, the rejection under 35 U.S.C. 112, first paragraph of claims 6 and 7 and the rejection under 35 U.S.C. 112, second paragraph of claim 1 are withdrawn.

8. Applicants traverse the rejection under 35 U.S.C. § 102(e) and/or 103(a) of claims 1-10 over Tsubakimoto as being in error (page 8, 3<sup>rd</sup> paragraph). Applicant's arguments have been fully considered but they are not persuasive.

9. Applicants contend that the '082 patent (Tsubakimoto et al.) is directed to the standard prior art method of preparing an SAP. In particular, a solution of acrylic acid (AA) is partially neutralized with sodium hydroxide to provide a monomer solution containing sodium acrylate and unneutralized AA. The sodium acrylate is prepared *in situ* and is not added to the monomer solution as a solid, which is recited *element* of each of the original and pending claims.

In particular, the '082 patent states that 'the acrylate salt (B) used in the present invention is composed of 0 to 50 mol % of acrylic acid and 50 to 100 mol % of an alkali metal acrylate" (col. 3, lines 20-22). The '082 patent does not disclose how this monomer (b) was produced. The examples of '082 further state that a solution of sodium acrylate and AA was used (Example 1, col. 7, lines 32-38). The '082 patent contains no disclosure relating to using a solid sodium acrylate as the source of a monomer in the preparation of an SAP (page 8, 4<sup>th</sup> paragraph through page 9, 1<sup>st</sup> paragraph).

Furthermore, Applicants contend that the '082 patent fails to teach or suggest using a solid sodium acrylate as a component to form a monomer solution. (page 9, 3<sup>rd</sup> paragraph). Person skilled in the art, after reading the '082 patent, would have had no motivation or incentive to substitute a solid sodium acrylate for sodium acrylate

prepared in situ with any reasonable expectation of achieving the new and unexpected results achieved by presently claimed invention (page 10, 2<sup>nd</sup> paragraph).

10. The reference clearly teaches the usage of an aqueous solution of sodium acrylate (see examples 1-3, col. 7, line 29 through col. 8, line 61). As a matter of fact, there are only two main ways of the preparation of an aqueous solution of sodium acrylate:

1. mixing aqueous sodium hydroxide with acrylic acid, or
2. dissolving commercially available solid sodium acrylate, 97% [7446-81-3] (acrylic acid, sodium salt), FW 94.05, mp>300<sup>0</sup>C in an aqueous medium.

Therefore, as per *In re Schaumann*, 572 F.2d 312, 197 USPQ 5 (CCPA 1978), when the reference teaches a small genus (two species in this application) which places a claimed species in the possession of the public.

11. In the light of the discussion above, the rejection of record has not been withdrawn. The rejection remains in force.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Conclusion***

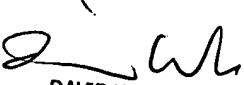
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bernshteyn whose telephone number is 571-272-2411. The examiner can normally be reached on M-F 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Bernshteyn  
Examiner  
Art Unit 1713

MB  
06/12/2006

  
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